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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,301	12/30/2003	Xing Su	INTEL1240 (P16229)	1668
28213	7590	12/03/2004	EXAMINER	
GRAY CARY WARE & FREIDENRICH LLP 4365 EXECUTIVE DRIVE SUITE 1100 SAN DIEGO, CA 92121-2133			YU, MELANIE J	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/750,301	SU ET AL.	
	Examiner	Art Unit	
	Melanie Yu	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 13-32 and 35-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed December 30, 2003 has been acknowledged. Claims 41-93 are canceled.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12 and 33-34 are drawn to a gel matrix containing one or more SERS-enhancing nanoparticles, classified in class 422, subclass 82.05.
 - II. Claims 13-15 are drawn to a method of producing a gel matrix, classified in class 436, subclass 164.
 - III. Claims 16-32 are drawn to a method of detecting an analyte, classified in class 435, subclass 4.
 - IV. Claims 35-40 are drawn to a method for multiplex detection of target molecules, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of group I and group II are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different and materially different process. The nanoparticles can be embedded into the gel matrix after formation instead of incorporated into the matrix during formation.

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3. Inventions of a) group I and b) each of groups II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in the materially different processes of group III or IV.

4. Inventions of a) group II and b) each of groups III and IV are patentably distinct. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The method of group II requires obtaining a solid gel matrix, which is not required by the methods of groups III or IV. The method of groups III and IV require separating a complex by electrophoresis, which is not required by the method of group II.

5. Inventions of group III and group IV are patentably distinct. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects. The method of group III requires detecting of SERS signals, which is not required by the method of group IV. The method of group IV requires associating optical signatures, which is not required by the method of group III.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and have acquired a separate

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status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of M.P.E.P.

§821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the

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product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See M.P.E.P. § 804.01.

7. During a telephone conversation with Dr. Lisa Haile on October 19, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12, 33, and 34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-32 and 35-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Bruchez et al. (US 2002/0155507).

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Bruchez et al. teach a solid gel matrix comprising a solid gel ([0196]) and one or more SERS-enhancing nanoparticles ([0015]) with an attached probe that binds specifically to an analyte ([0110]; [0126]). While Bruchez et al. only describes a specific molecule being conjugated with a semiconductor nanocrystal (SCNC), it is noted that Bruchez et al. teach that SCNCs may also be light-scattering metallic nanoparticles ([0083]), therefore specific molecules may also be conjugated to a SERS-enhancing nanoparticle.

Bruchez et al. teach a plurality of nanoparticles to provide a plurality of unique optical signatures ([0051], [0193]), wherein each nanoparticle provides a unique SERS-signal ([0015], [0016], [0133]). Bruchez et al. also teach at least one nanoparticle having a net charge ([0278]).

Regarding claims 7-11, Bruchez et al. teach the nanoparticle comprising a core comprising a metallic colloid ([0083], [0084], [0051]), a second metal different from the first metal forming a layer overlying the surface of the nanoparticle ([0083]), and an organic layer overlying the metal layer, which organic layer comprising a probe ([0110]), wherein the probe is a polynucleotide ([0061], [0069], [0127]). Bruchez et al. also teach at least some of the nanoparticles further comprising a fluorescent label that contributes to the optical signature ([0084]).

Regarding claims 33 and 34, Bruchez et al. teach a system comprising: a gel matrix, disclosed above, a sample containing at least one analyte ([0134]), an optical detection system suitable for detecting SERS signals from the nanoparticles ([0214]), and a computer comprising an algorithm for analysis of the SERS signals obtained from the sample ([0172], [0186]).

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruchez et al. (US 2002/0155507) in view of Mirkin et al. (US 2003/0211488).

Bruchez et al., as disclosed above, teach a solid gel matrix wherein the SERS enhancing nanoparticles comprise one or more Raman-active tags ([0125]), but fail to teach the specific tag.

Mirkin et al. teach a Raman-active tag being an analog of adenine, poly-adenine ([0181]) or fluorescent dyes ([0142]), in order to utilize a spectroscopic fingerprint in detection.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the solid gel matrix of Bruchez et al., Raman active tags of an analog of adenine or a fluorescent dye, in order to create distinguishable labels.

Conclusion

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Yu whose telephone number is (571) 272-2933. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melanie Yu
Patent Examiner
Art Unit 1641



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11/24/04